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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,884	06/07/2001	Toru Kuwahara	100809-16268 (SCET 18.735	7823
26304	7590	02/15/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			APPLE, KIRSTEN SACHWITZ	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/876,884	Applicant(s) KUWAHARA, TORU	
	Examiner Kirsten S. Apple	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/25/04</u> <u>1/20/04</u> <u>+ 11/25/02</u> | 6) <input type="checkbox"/> Other: ____ |

3/25/04 + 3/21/05

Detailed Action

This action is in response to the application filed on 06/07/2001.

Specification

The specification is replete with errors and the entire specification should be reviewed in its entirety for typographical and grammatical errors. Appropriate correction is required. It is clear that the application is simply a translation and difficult for the examiner to understand.

For example, in the abstract:

"A store apparatus 1" It is unclear to the examiner if you mean "one store apparatus" or "store apparatus item number 1." If you mean "one store apparatus" the word "store apparatus" is unclear to one of ordinary skill in the art. The examiner will assume you are referring to a "store register." Additional, item numbers should not be used in an abstract only in the Brief description of drawings.

Similar grammatical error, unclear language or awkward wording is through out the entire specification. This Appropriate correction is required for items listed above.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11 & 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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In particular, at least the independent claims recite a "program." The examiner is interpreting the program as a "computer program." The MPEP section 2106 (page 2100-13 of MPEP version 8) clearly outlines "Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

Corrective action to Claims 11 & 12 is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (U.S. Patent 6,594,640) in view of Riordan (U.S. Patent 6,078,891.)

Re claim 1, 7 & 9-14: Postrel discloses:

A system and method for operating a reward points accumulation and redemption program with a first (see Postrel, Figure 5, item 10), second (see Postrel, Figure 5, Item 40) and third storage means (see Postrel, Figure 5, Item 30).

It is clear that Postrel system would be capable of handling such information. The examiner would like to point that that with respect to the

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additional citation in the claim the currently claim language of “for” is interpreted as intended use only.

Although Postrel does not have specifically describe judging for “combinations of commodities” Riordan specifically teaches “bundle together the sale of two or more items” (See Riordan, Column 9, line 22) and it is commonly known to one of ordinary skill in the art to have marketing promotions that consist of “bundled offers.”

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add bundled offers as taught in Riordan to Postrel.

It is clear that one would be motivated because this would create unique offer that would attract shoppers.

Claim 1 is similar to claim 7 & 9-14. It would be obvious to one of ordinary skill in the art that these claim have similar limitation. Therefore, claims 7 & 9-14 are rejected based on the information provided regarding claim 1.

Re claim 2: Postrel discloses:

A system and method for operating a reward points accumulation and redemption program comprising: receiving an order request, calculation points for redemption. (see Postrel, background of invention, page 1, lines 2-10).

Although Postrel does not have specifically describe judging for “combinations of commodities” Riordan specifically teaches “bundle together the sale of two or more items” (See Riordan, Column 9, line 22) and it is commonly

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known to one of ordinary skill in the art to have marketing promotions that consist of “bundled offers.”

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add bundled offers as taught in Riordan to Postrel.

It is clear that one would be motivated because this would create unique offer that would attract shoppers.

Re claim 3: Postrel discloses:

A system and method for operating a reward points accumulation and redemption program receiving user information (see Postrel, Fig 5, Item 54 “user redemption profile”) and storing user points (see Postrel, Fig 5, Item 54 “user accounts”).

Additionally, the examiner would like to point that that with respect to the additional citation in the claim the currently claim language of “for” is interpreted as intended use only.

Re claim 4: Postrel discloses:

A system and method for operating a reward points accumulation and redemption program utilizes a “reward server conversion rate” (see Postrel, Fig 5, Item 54).

Re claim 5: Postrel discloses:

A system and method for operating a reward points accumulation and redemption program utilizes a “reward server conversion rate” (see Postrel, Fig 5, Item 54).

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Although Postrel does not have specifically describe judging for “combinations of commodities” Riordan specifically teaches “bundle together the sale of two or more items” (See Riordan, Column 9, line 22) and it is commonly known to one of ordinary skill in the art to have marketing promotions that consist of “bundled offers.”

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add bundled offers as taught in Riordan to Postrel. It is clear that Postrel specifics “rates” more than one used for different situations. One such situation could be the “bundled sale” or “combination of commodities.”

It is clear that one would be motivated because this would create unique offer that would attract shoppers.

Re claim 6: Postrel discloses:

A system and method for operating a reward points accumulation and redemption program utilizes a “reward server conversion rate” (see Postrel, Fig 5, Item 54).

Re claim 8: Postrel discloses:

An order apparatus for operating a reward points accumulation and redemption program utilizes containing a fourth storage (see Postrel, Figure 5, “user accounts”)

It is clear that Postrel system would be capable of handling such information. The examiner would like to point that that with respect to the

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additional citation in the claim the currently claim language of "for" is interpreted as intended use only.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on 571.272.6799. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa


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